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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

THOMPSON, MARC D

ART UNIT

PAPER NUMBER

2144

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/021,511

Applicant(s)

ANDRA ET AL.

Examiner

Marc D. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/7/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This application has been examined.
2. Amendment A, Paper #2, received 12/7/2001, has been entered into record.
3. Claims 15-19 are now pending.

Priority

4. This application claims priority to parent application 09/092,389.
5. The effective filing date for the subject matter defined in the pending claims in this application is 6/5/1998.

Drawings

6. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.
7. The Examiner contends that the drawings submitted on 12/7/2001 are acceptable for examination proceedings.

Specification

8. The disclosure is objected to because of the following informalities:

The amendment submitted on 12/7/2001 amended the specification to include continuation information in the first line of the written description. This section properly conforms to former 37 CFR 1.60, which requires the necessary reference to the prior application as the first sentence of the specification. However, the current status of all nonprovisional parent

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applications referenced should be included. The pre-amendment failed to recite the Patent Number which this priority document has matured into (i.e., United States Patent 6,349,331).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 15-17 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

11. Claim 15 recites “autonegotiating the second...device without ceasing network communication with the second...device” in Lines 15-17 of the claim. The specification fails to provide adequate support and description for autonegotiating without “breaking” the link to which this device is connected which is/will undergo autonegotiation. The process of autonegotiation requires a “link failure” status, minimally, to alert the remote device on the link that autonegotiation is/will occur. An ordinary artisan would be forced to resort to undue experimentation at the time of invention to perform autonegotiation without first providing a failed link status recognized by both end points. Thus, the provision for “autonegotiation without ceasing communication [on the link]”, is unsupported by the present specification, and

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lacks adequate description to enable one skilled in the art at the time of invention to make and use the invention.

12. Claims 16-17 inherit this descriptive deficiency.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 15-19 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Claim 15 recites “autonegotiating the first communication device”. Autonegotiation relates to communication link(s) requiring two communicating devices. Thus, it will be presumed that this autonegotiation being performed directly involves a connection (link) between the first device and other device(s) on the network. Likewise, all instances of “communication devices” which undergo “auto-negotiation” are understood to involve the network link associated with these particular communication devices.

16. Claim 19 recites “selectively ceasing network communication...based upon status of the second network device during autonegotiation of the first network device” in Lines 11-14 of the claim. First, the recitation “based upon status of...” fails to specify what status determination effect which, if any, functional occurrences in the system. Further, the omission of any conditions for execution of this “selective” functionality renders this claim indefinite. For example, it is unclear whether the “ceasing of network communication between the autonegotiation controller and the second network device” occur due to a change of the “status of

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the second network device during autonegotiation of the first device”, as previously interpreted and argued by Applicant in the Response, Paper #2, received on 12/7/2001, in regard to claim 15. Simply, “based upon status” does not confer any particular operation(s), nor is the claim specific enough to ascertain what happens, if anything, in response to particular device status or status changes. It will be presumed that Applicant intends to have commensurate scope of claims 15 and 19, since claim 19 is not argued separately from claim 15. Claim 19 will be interpreted to include this “status change” determination.

17. Claim 16 recites “the step of ceasing network inactivity” in Lines 1-2 of the claim. There is lack of antecedent basis for this limitation in the claim. It is presumed this limitation relates to ceasing network communication according to the duration specified in the `break_link_timer`.

18. Claim 17 is presumed to contain a typographical error in the phrase “comprises and interval” in Line 2 of the claim. Further, this claim uses the term “approximately” to describe bounds of an interval, which is inherently indefinite.

19. Claim 18 recites “the ports” in Lines 4 of the claim. There is a lack of antecedent basis for this limitation in the claims.

20. Claim 18 recites functionality including “steps for sequentially autonegotiating the ports”, and “steps for initiating a `break_link_timer` a number of iterations that is less than the plural number of ports”. Two points are raised in the addressing of this claim:

1. If the ports are “sequentially autonegotiated” as claimed, Applicant arguments on Pages 4 and 5 of the response, Amendment A, filed 12/7/2001, are inconsistent with this specifically stated functional occurrence. Since the ports are sequentially autonegotiated, selective autonegotiation of ports or devices cannot occur.

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2. If a “break_link_timer” is “initiated a number of iterations that is less than the number of ports”, there MUST be some ports which are not autonegotiated or are otherwise excluded from the autonegotiation sequence. On power-up, a “break_link_timer” is not required, since the “broken” link status is understood by both units on the link (waiting for the other side to recognize a broken link is pointless). In this case, the number of initiations of the “break_link_timer” is clearly less than the number of ports. Conversely, the number of ports to be autonegotiated is less than or equal to the number of actual ports. Thus, typically, when a subset of the ports are to be autonegotiated, or more accurately reautonegotiated, since the number of ports to be “sequentially autonegotiated” is less than the number of ports, the “iterations” of “initiation of a break_link_timer” are less than the number of ports.

Lastly, claim 18 exhibits such extreme breadth that no ascertainable metes and bounds can be associated therewith, nor can any functional interaction between the alleged elements in the claim be appropriately surmised. The basic lacking for this claim to display any description of what physical element(s) perform the claimed “steps”, functional interaction between any physical elements of the system, and resultant determinations, decision parameters, and clear and concisely stated functional procedures, renders it hopelessly indefinite. In short, the claim in the current form fails to include necessary recitations/steps which are required for minimal operation of the invention. Also, discussion at Page 6 of the response, Amendment A, filed 12/7/2001, fails to properly frame the claimed invention, since the claim does not require ANY of the discussed functionality to occur, that is, status checking, generation or execution of autonegotiation requests, second port(s) autonegotiation proceeding without break_link_timer, time period expiration since the request, status monitoring, or selective execution/processing of

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anything. Since it is noted that these specific features (and perhaps more) upon which Applicant relies for claim interpretation are not specifically recited in the rejected claim, patentable weight cannot be justly associated. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appropriate correction is required.

Double Patenting

21. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

22. Claims 15-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over, inter alia, claim 1 of U.S. Patent Number 6,349,331 (ANDRA et al.), hereinafter referred to as Andra.

23. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are broader than the patented claims. Claim 1 of U.S. Patent Number 6,349,331 contains every element of claims 15-19 of the instant application, and as such, this document anticipate(s) the claims of the instant application. Additionally, other

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claims of Andra provide further details of the system which may become present in the claimed invention subsequent to potential amendment(s).

24. Also, since the omission of element(s) not desired is an obvious modification of a base system (See MPEP § 2144.04), the presented claims would have been obvious in light of the patented claims as set forth in Andra.

A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). *ELI LILLY AND COMPANY v BARR LABORATORIES, INC.*, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 102

25. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

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(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

26. Claim 18 is rejected under 35 U.S.C. §102(e) as being anticipated by Patel et al. (U.S. Patent Number 6,148,002), hereinafter referred to as Patel.

27. Patel disclosed one embodiment including performing a “round-robin” autonegotiation procedure. See, inter alia, Patel, Column 3, Lines 18-40, Column 5, Lines 21-33, and Page 4 of the response, Amendment A, filed 12/7/2001. However, Patel was not limited to only this type of port status sequencing. See, inter alia, Column 5, Lines 33-35. The initiation of a “break_link_timer”, as claimed, was inherently present in an autonegotiation system, since arguably, Patel does not expressly disclose initiating a break_link_timer at all. See, for example, Pages 5-6 of the response, Amendment A, filed 12/7/2001. Thus, the “break_link_timer” was initiated less than the number of ports undergoing autonegotiation processing. In reality, a “break_link_timer” (break connection for this long so renegotiation can proceed) was required for autonegotiation, since the autonegotiation establishes a new, hopefully better, connection transfer speed. The system of Patel specifically described after power-up, selective ports are autonegotiated. See, inter alia, Column 3, Lines 26-33. Since these selective ports are less than the total number of ports, or even if arguably this was a special case, the number of “break_link_timer” initiations would be less than the number of ports of the device.

28. Thus, the claimed invention was described by Patel as follows:

(claim 18)

a. *steps for sequentially autonegotiating the ports*, was taught by Patel, inter alia, in Column 2, Line 62 through Column 3, Line 5.

b. *steps for initiating a break_link_timer a number of iterations that is less than the plural number of ports*, was taught by Patel, since, the use of a “break_link_timer” was inherently involved in the autonegotiation of Patel, since the switching to an ‘unresolved’ state of the link was a (logical) ‘breaking’ of the connection necessarily prior to autonegotiation. Since only some of the ports are (re)autonegotiated at some given time of operation, the limitation is met.

Thus, the invention as broadly claimed, as interpreted by the Examiner, was disclosed by Patel.

Response to Arguments

29. The arguments presented by Applicant in the pre-amendment, Paper #2, received on 12/7/2001, are not considered entirely persuasive.

30. Applicant argues the prior art does not “teach or suggest selectively autonegotiating without ceasing network communication as set forth in claim 15”. See, Response, Paper #2, received on 12/7/2001, Page 4, Lines 26-30. It is submitted that Claim 15 does not provide this recited functionality, minimally, since the word “selectively” is not included in the claim. Further, since link_fail states are required for autonegotiation, it is impossible to gauge what this is attempting to describe. Lastly, the extent of any “selective” processing of this type is based upon if the “status of the second [] communication device did not change...” It remains unclear what conditions must be met for the processing to be enacted. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Allowable Subject Matter

31. The avoidance of the use of a break_link_timer for a particular device or port if an autonegotiation request for said particular device or port was generated (inherently involving a previous 'broken link' indication in this instance) before the break_link_timer was initiated for any of the previous devices or ports in the autonegotiation sequence, where the link status of said particular device or port did not change after the autonegotiation request generation, was not fairly taught or suggested by the prior art of record. That is, the verification that at least one break_link_timer interval has elapsed, and the status of an arbitrary second (or subsequent) port or device in an autonegotiation or reautonegotiation sequence has not changed (is still 'down') during the previous autonegotiation process(es), resulting in the execution of immediate autonegotiation without further break_link_timer expiration, was not taught or suggested by the prior art of record. This functionality is supported, inter alia, by the present specification at Pages 12-14, and the Applicant arguments in the Response, Paper #2, received on 12/7/2001, Pages 5-6.

Conclusion

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

33. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marc Thompson whose telephone number is (703) 308-6750. The Examiner can normally be reached on Monday-Friday from 9am to 4pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, William

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Cuchlinski, Jr., can be reached at (703) 308-3873. The fax phone number for this Group is (703) 872-9306. Inquiries of a general nature relating to the general status of this application or proceeding should be directed to the 2100 Group receptionist whose telephone number is (703) 305-3900.

MARC D. THOMPSON
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PRIMARY EXAMINER

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